

## REMARKS

Claims 1-5, 7, 10, 14, and 16 have been amended; claims 15, 17 and 18 have been canceled; and new claims 36-46 have been added. Claims 1-14, 16, and 36-46 (26 total) are in the application; claims 1, 14 and 36 are independent. Since 35 total claims have been paid for, no fee is due on account of the number of claims presented in this Amendment.

The applicant believes that support in the specification and drawings for all of the claim amendments will be readily apparent. For example, the recitation of a funnel-shaped cap magnet in amended claim 4 is discussed at paragraph 0054 of the original specification. Likewise, paragraph 0055 points out that the structure of the funnel-shaped cap lumen can be replicated in the trocar base, thus supporting new claim 38. Finally, subject matter in new claim 46 is disclosed in paragraph 0058.

Regarding a housekeeping matter, the Amendment dated October 8, 2009, included a Submission of Drawing Change with a replacement sheet seven of the drawings that included a minor change in Fig. 8. It is requested that the next office action in the present application indicate that replacement sheet seven has been entered into the application.

The applicant wishes to thank the examiner for the courtesies extended to his undersigned attorney in a telephone interview on November 23, 2009. The substance of the interview is included in these remarks.

Taking claim 14 as exemplary for the moment, it recites a trocar that comprises an elongated cannula for extending through a tissue boundary. The cannula has a distal end for placement on one side of the tissue boundary and a proximal end for placement on another side of the tissue boundary, with a trocar base at the cannula's proximal end and a trocar lumen extending axially from a proximal end of the base to the distal end of the cannula. The trocar has a magnet in the base, and in a feature significant to the discussion

that follows, the magnet comprises an annular disc at the proximal end of the base and surrounding the lumen for creating a magnetic field generally axially aligned with the lumen. The magnet has a predetermined strength for holding a distal end of an elongated surgical instrument in place in alignment with the lumen. The limitation that the magnet “comprises an annular disc disposed at said proximal end of said base surrounding said lumen” is taken from canceled dependent claim 15.

Turning to the office action, claims 14 and 15 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent 4,338,937 to Lerman. Claims 1-5, 7, and 9-11 were rejected under 35 U.S.C. § 103 as reciting subject matter that would have been obvious from Lerman in view of U.S. Patent 6,537,290 to Adams et al.

Lerman discloses a continent ileostomy or colostomy having an insert 40 with a stem portion 42 and a rim portion 44 that forms a flange on the stem portion. Four small magnets 52 are spaced circumferentially at equidistant locations on the rim portion 44, as seen in Fig. 2, which also shows a cooperating set of four small magnets 86 located on the underside of a stopper 80. The office action equated the discrete magnets 52 with claim 15’s magnet comprising an annular disc at the proximal end of the base and surrounding the lumen. However, Lerman’s small, discrete magnets spaced 90° apart on the rim 44 and the stopper 80 do not meet this limitation. In addition, there is clearly nothing in Lerman that would have suggested using an annular magnet as recited in claim 15 (and now in independent claim 14). Nor would Lerman’s discrete magnets function as an annular disc. The cross hatching in Fig. 1 shows that the insert 40 is made of synthetic resin or plastic, *see* M.P.E.P. § 608.02 IX, and nothing in Lerman suggests that the insert 40 could be a magnetically permeable material. *See also* Lerman at col. 2, lines 11-13. Finally, the office

action does not contend that Adams would have suggested the subject matter of claim 15 to one of ordinary skill in the art.

The examiner tentatively agreed in the telephone interview that claim 14 would be allowable over Lerman and Adams with the subject matter of claim 15 incorporated therein.

In the interview, the applicant pointed out that the present application had been subject to an election of species requirement in the office action of September 25, 2009. Relevant to the current office action is the identification in the election requirement of the embodiment of Figs. 1-3 of the present application as a species separate from the embodiment of Figs. 4 and 5 of the present application. Figs. 1-3 show an annular magnetic member 20 that corresponds to claim 14's "annular disc disposed at said proximal end of said base surrounding said lumen." In contrast, Figs. 4 and 5 show a plurality of discrete magnetic members 52a, 52b, 52c, 52d, 52e, 52f, 52g, and 52h. As stated in the election requirement, "[T]hese species are not obvious variants of each other based on the current record." Office action of September 25, 2009, at 5.

Accordingly, the September 25 office action confirms that separate magnets spaced apart around a lumen neither are the same as nor would render obvious a magnet comprising "an annular disc disposed at said proximal end of said base surrounding said lumen," as now recited in claim 14.

Regarding independent claim 1, it has been amended likewise to recite a trocar that "includes a magnet comprising an annular disc disposed at said proximal end of said base surrounding said trocar lumen," thus making it allowable over the art of record for the same reasons as claim 14. New independent claim 36 includes the salient features of amended claims 1 and 14 that place them in allowable condition over the art of record. In

particular, claim 36 recites "a magnet in said base including an annular member surrounding said lumen for creating a magnetic field generally axially aligned with said lumen." The presence of at least this structure in claim 36 renders it patentable over the art of record for the reasons already discussed with regard to claims 1 and 14.

For the reasons discussed above, the applicant believes that claims 1-14, 16, and 36-46 are allowable over the art of record, and allowance of the present application is respectfully requested.

Any fee associated with this paper should be charged to Deposit Account No. 50-0409.

If the examiner has any questions regarding this application, he is requested to telephone the applicant's below attorney. All correspondence should be sent to the attorney named below at the address shown.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David M. Quinlan", written over a horizontal line.

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